

REMARKS

This application has been carefully reviewed in light of the Office Action dated August 24, 2004. Claims 1-6 and 9-10 remain pending in this application. Claim 1 is the independent claim. Favorable reconsideration is respectfully requested.

Applicants note with appreciation the indication that Claims 3-6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants respectfully refrain from so amending Claims 3-6 at this time because they believe their base claims to be allowable.

On the merits, the Office Action rejected Claims 1-2, 9-10 under 35 U.S.C. § 102(b) as being anticipated by Van Der Werf et al. (U.S. Patent No. 6,122,058; hereinafter "Van Der Werf"). Applicants respectfully believe the Claims allowable for at least the following reasons:

Van Der Werf fails to recite or suggest a detector for detecting an intensity of light reflected off the surface to be inspected. Rather, Van Der Werf recites an interferometer which measures variations in the refractive index between a measuring beam and a laser beam. (See, e.g., Col. 17, lines 30-60) In

addition, Van Der Werf requires two detectors 140 and 141 to measure refractive index variations.

The Office Action argues that although Van Der Werf fails to explicitly recite detecting an intensity of the light, it is inherent to the operation of a detector in interferometry. The Office Action argues: "[detector light intensity detection] is key in determining whether there is constructive interference or destructive interference..." In response, Applicants respectfully note that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art (as opposed to the examiner's expectation). Mere possibilities or even probabilities are not enough; necessity recognized by those of skill in the art is required.¹ The M.P.E.P. echoes this case law.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

¹ The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Oelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansgry v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

Further, the following is also emphasized:

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

It is well established that a recited element or step is inherently present in a prior art reference only if that element is necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. Second, the Office Action must provide objective evidence or cogent technical reasoning to support a contention of inherency.²

Simply because, as the Office Action alleges, Van Der Werf recites interferometry, this does not necessarily mean the detectors detect an intensity of light. Rather, Van Der Werf only recites measuring variations in the refractive index between a measuring beam and a laser beam. (See, e.g., Col. 17, lines 30-60) The detectors of Van Der Werf would then only necessarily detect the refractive index of the beam they receive. Thus Applicants

² "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

respectfully traverse the inherency argument as well as the § 102 rejection of Claim 1 for at least the above reasons.

Claim 9 recites a method substantially corresponding to the device of Claim 1 and is believed patentable for at least the same reasons.

Claims 2 and 10 depend from one or another of the independent claims discussed above and are believed patentable for at least the same reasons. In addition, Applicants respectfully believe Claims 2 and 10 to be independently patentable and request separate consideration of each claim.

In view of the foregoing amendments and remarks, Applicants respectfully submit that the currently-pending claims are clearly patentable. Accordingly, entry of this amendment, reconsideration of the rejections of the claims over the references cited, and allowance of this application is earnestly solicited.

Respectfully submitted,

By 

Aaron Waxler,

Reg. No. 48,027

Attorney

(914) 333-9608

October 11, 2004